

Jan 12 04 09:39p

Donald R. Greene

480.488.5654

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OFFICIAL

ATTORNEY'S DOCKET NO. ISM/012

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Application of

A. SHENNIB ET AL.

Serial No. 09/475,923

Filed: December 30, 1999

Confirmation No. 7053

Group Art Unit 2643

Examiner: P. L. Dabney

JAN 12 2004

#17
2/10/04
3L
(NE)

Title: DIRECT TYMPANIC DRIVE VIA A FLOATING FILAMENT ASSEMBLY

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF FACSIMILE TRANSMISSION UNDER 37 CFR 1.8

To: *United States Patent and Trademark Office (USPTO)*

City: *Alexandria, Virginia*

Central Fax No.: *703-872-9306*

Total pages: 18, including this cover sheet.

The undersigned attorney of record certifies that this certificate, a 3-page Letter responsive to the Office Action of 08/12/2003; copies of a 1-page letter dated 12/30/1999, 1-page Express Mail Certificate dated 04/09/2000, and 11-page merger documentation; and a 1-page Credit Card Payment (Form PTO-2038) in the amount of \$210.00 for a 2-month extension of time (small entity) are being facsimile transmitted to the above USPTO Central Facsimile Number on 01/12/2004, in accordance with the OG Notice of 28 October 2003.

By DRG
Donald R. Greene
Reg. No. 22470
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Scottsdale, AZ 85267-2995
Telephone: 480.488.9895
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Dated: 01/12/2004

Enclosures (as listed)

01/13/2004 NSEBREM1 00000112 09475923

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LETTER

Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

Sir/Madam:

This letter, together with enclosures cited below, is submitted in response to the Office Action of 08/12/2003, which was made final by the examiner.

A Terminal Disclaimer relative to Shennib US 6,137,889 was filed by applicant's attorney in this application on 07/29/2003, and was indicated in the Action dated 08/12/2003 as having been reviewed and accepted, and the Terminal Disclaimer recorded. When the Terminal Disclaimer was filed, applicant's attorney requested that Shennib '889 be withdrawn as prior art, on the grounds that it served to eliminate the obviousness-type double patenting rejection and, as a consequence, to eliminate any assertion that applicant is seeking an extension of its patent monopoly with respect to the present application and the commonly-owned Shennib '889 patent, coupled with examiner's acknowledgment that the claims of the present application are not identical to those of Shennib '889.

Examiner has asserted with respect to the 102(e) rejection set forth earlier and repeated in the Office Action of 08/12/2003, that according to MPEP section 804 applicant must furnish evidence that the subject matter of Shennib '889 and of the claimed invention herein were, at the time the invention was made, owned by the same entity or subject to an obligation of assignment to the same entity. That evidence is submitted herewith as follows.

The assignment by the inventors of the invention claimed in the Shennib '889 patent to InSonus Medical, Inc., a California corporation, was recorded in the PTO at Reel 9224/Frame 0180 on 05/27/1998, and the assignment by the inventors of the invention claimed in the present application to the same entity, InSonus Medical, Inc., a California corporation, was recorded in the PTO at Reel 10692//Frame 0789 on 04/10/2000. These recordations are readily verifiable by the examiner.

Also filed herewith is a copy of a letter dated 12/30/1999, the filing date of the present application, from applicant's attorney to the president of InSonus Medical, a named inventor in both cases, that forwarded a copy of the as-filed application, and stated that the assignment document along with missing parts of the application (declaration, filing fee, etc.) would be filed (and subsequently were in fact filed, as evidenced by enclosed copy of an Express Mail Certificate dated 04/09/2000) upon receipt of a PTO Notice to File Missing Parts.

Further filed herewith is a document of Agreement and Plan of Merger together with certificates by the Secretaries of State of Delaware and California, evidencing that InSonus Medical, Inc. and its wholly-owned subsidiary, InSound Medical, Inc, a Delaware corporation, were merged effective 01/08/2002, in which InSound Medical, Inc. became the surviving corporation, so that it now holds title to both the Shennib '889 patent and the present application.

Accordingly, since applicant has furnished herewith the necessary evidence of common ownership of the subject matter of the reference and the claimed invention, at the time the invention was made, it is respectfully requested that the rejection of claims under 35 U.S.C. 102(e) be withdrawn.

Applicant requests a 2-month extension of time for response to the Action of 08/12/2003, and also submits herewith payment for such extension of time for this submission, by Credit Card Payment Form PTO-2038.

In view of the above submissions and remarks, it is submitted that this application is in condition for allowance.

Respectfully submitted,
ADNAN SHENNIB ET AL.



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Dated: 01/12/2004

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ATTORNEY DOCKET ISM/012

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December 30, 1999

VIA PRIORITY MAIL

Adnan Shennib
InSonus Medical, Inc.
2506-B Technology Drive
Hayward, CA 94545

Re: U.S. Patent Application on Direct Tympanic Drive, A. Shennib et al.
Attorney Docket: ISM/012

Dear Adnan:

Enclosed herewith is a complete copy of the above-referenced patent application as it was filed in the PTO by Express Mail on December 30, 1999. The filing was made without inclusion of signed documents (Declaration and Power of Attorney, Assignment, and Small Entity Verifications) or payment of fees, but we will nevertheless receive a filing date of December 30, 1999 and a serial number.

We will be receiving a Notice within the next month from the PTO to file those missing documents and fees. The period for reply to that Notice is two months from the date the Notice is mailed (unless an extension is obtained at extra cost). I will forward a copy of the Notice as soon as it is received, along with the appropriate documents to be signed and a pro forma invoice for the government fees. The fee calculation is shown on one of the enclosed sheets (incidentally, the basic small entity filing fee was reduced by \$35, to \$345, effective December 29), but does not include the \$65.00 surcharge imposed by the PTO for late filing fee. Please do not sign the Declaration or any other document enclosed with this letter since they are merely samples that were filed.

Call me if you have any questions.

Sincerely,


Donald R. Greene

Enclosures (as indicated)

DRG/ESD/ASL/TR 012/12309

Jan. 12 04 09:40p

Donald R. Greene

480.488.5654

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EXPRESS MAIL LABEL NO. EK 444 149 125 US
ATTORNEY'S DOCKET: ISM/012

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

ADNAN SHENNIB, ET AL.

Serial No.: 09/475,923

Filed: December 30, 1999

Group Art Unit 2743

Examiner: _____

Title: DIRECT TYMPANIC DRIVE VIA A FLOATING FILAMENT ASSEMBLY

EXPRESS MAIL CERTIFICATE

Express Mail Label No. EK 444 149 125 US

Date of Deposit: April 9, 2000

I hereby certify that the following attached papers:

- (1) Document Transmittal (including fee calculation);
- (2) Executed Combined Declaration and Power of Attorney;
- (3) Executed Assignment and Recordation Form;
- (4) Executed Small Entity Verification - Small Business Concern (Assignee);
- (5) Copy of Notice to File Missing Parts;
- (6) Check to Commissioner for \$1,273.00, with request for refund
of excess \$40.00; and
- (7) Postcard (stamped, addressed) for acknowledging receipt.

are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above, addressed to the Commissioner of Patents and Trademarks, Washington, D.C. 20231, Attention: Box Missing Parts.



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DRG/DSMICKEYLD12/04090